



**JOLLIBEE FOODS CORPORATION,**  
Opposer,

**-versus-**

**HUHTAMAKI FINANCE B.V.,**  
Respondent-Applicant.

}  
}  
}  
}  
}  
}  
}  
}  
}  
}  
}

**IPC No. 14-2013-00312**  
Opposition to:  
Application No.4-2012-013201  
Date filed: 29 October 2012  
TM: " **JOLLY RANCHER**"

X-----X

### NOTICE OF DECISION

**QUISUMBING TORRES**

Counsel for Opposer  
12<sup>th</sup> Floor Net One Center  
26<sup>th</sup> Street corner 3<sup>rd</sup> Avenue  
Crescent Park West, Bonifacio Global City  
Taguig City

**ANGARA ABELLO CONCEPCION REGALA & CRUZ**

Counsel for Respondent-Applicant  
22<sup>nd</sup> Floor, ACCRALAW Tower  
Second Avenue corner 30<sup>th</sup> Street  
Crescent Park West, Bonifacio Global City  
0399 Taguig, Metro Manila

**GREETINGS:**

Please be informed that Decision No. 2015 - 92 dated May 18, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 18, 2015.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



**JOLLIBEE FOODS CORPORATION,**  
Opposer,

-versus-

**HUHTAMAKI FINANCE B.V.,**  
Respondent-Applicant.

X ----- X

IPC No. 14-2013-00312

Opposition to Trademark  
Application No. 4-2012-013201  
Date Filed: 29 October 2012  
Trademark: **"JOLLY RANCHER"**

Decision No. 2015- 92

### DECISION

Jollibee Foods Corporation<sup>1</sup> (Opposer) filed an opposition to Application No. 4-2012-013201. The contested application, filed by Huhtamaki Finance B.V.<sup>2</sup> (Respondent-Applicant), covers the mark "JOLLY RANCHER" for use on *"candy; confectionery; chewing gum; frozen confections namely, freezer pops, flavored ices; ice cream, ice cream bars; ice cream confections; frozen yogurt, frozen yogurt bars; sherbet"* under Class 30 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its claims on the provisions of paragraphs (d), (e) and (f) of Section 123 of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It insists that the Respondent-Applicant's mark "JOLLY RANCHER" is confusingly similar to its own "JOLLIBEE" and "JOLLY" marks. It explains that the first two syllables of the contending marks are identical. It also asserts that "JOLLY" in the Respondent-Applicant's applied mark is identical to its prior and subsisting registrations of "JOLLY 'ZERTS", "JOLLY SHAKES", "JOLLY KRUNCH TWIRL", "JOLLY CRISPY FRIES", "JOLLY CHEEZY FRIES" and "JOLLY HOTDOG" as well as to its allegedly well-known mark, "JOLLIBEE". It laments that the confusion is further enhanced since the mark "JOLLY RANCHER" is to be used on goods which are the same and directly competing with its own.

According to the Opposer, the company now has seven hundred eighty three (783) restaurants in the Philippines since it first introduced its mark on 26 January 1978. It claims, among others, that it has ninety-four (94) restaurants abroad since it first branched out in Taiwan in 1986. In total, it claims to have eight hundred seventy (870) restaurants worldwide. In the Philippines, it maintains ownership over seventy-seven (77) trademark registrations and nine (9) pending trademark applications. The Opposer believes its trademark is well-

<sup>1</sup>A corporation organized under the laws of the Philippines with address at 7<sup>th</sup> Floor, Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City.

<sup>2</sup>With address at Jupiterstraat 102, 2132 HE Hoofddorp, Netherlands.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

known based on the criteria set forth in Rule 102 of the Implementing Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers and likewise cites the case of Jollibee Foods Corporation vs. Atlas Publishing Company Inc. (IPC No. 14-2006-00113).

In support of its opposition, the Opposer submitted the following:<sup>4</sup>

1. decision of the IPO dated 25 February 2007 in Jollibee Foods Corporation vs. Atlas Publishing Company, Inc., IPC No. 14-2006-00113;
2. original notarized affidavit of Atty. Gonzalo D.V. Go III;
3. representative samples of Philippine registrations and application for the JOLLIBEE mark and other related JOLLIBEE and JOLLY TRADEMARKS;
4. representative samples of food packaging and containers bearing the JOLLIBEE Trademarks;
5. representative sample of promotional materials and advertisements in television programs, the internet, well-known print publications, in-store promotions, and outdoor promotions for products and services bearing the Jollibee Trademarks;
6. screenshots of Opposer's website, www.jollibee.com.ph, featuring various Jollibee items and food products, Jollibee restaurant locations on the Philippines and overseas, and other relevant information about Opposer;
7. table showing the details of Opposer's applications and registrations for the Jollibee trademarks worldwide;
8. representative samples of registrations and applications for the Jollibee Trademarks from different countries worldwide such as: Bahrain, Brazil, Canada, Hong Kong, India, Indonesia, Israel, Italy, Kuwait, Malaysia, Mexico, Oman, Saudi Arabia, Singapore, South Korea, Spain, United States of America and Vietnam;
9. various articles and blogs from different parts of the world attesting to the renown and the well-known status of Opposer and its Jollibee trademark worldwide;
10. the Opposer's coffee table book "a 25-Year Love Story with the Pinoy"
11. the Opposer's Power Point presentation shown to the participants of the Follow-up Session to the WIPO-Sweden Advanced Training Course on Industrial Property in the Global Economy;
12. the Opposer's Annual Reports from 2002 to 2011; and
13. list of awards received by the Opposer.

On 05 October 2013, the Respondent-Applicant filed its Answer denying that its applied mark "JOLLY RANCHER" is confusingly similar to the Opposer's "JOLLY" and "JOLLIBEE" marks reasoning that the latter merely focused on the first two syllables. It also contends that its mark is to be used on goods sold in

---

<sup>4</sup> Marked as Exhibits "B" to "W", inclusive.

retail stores while the Opposer's business is quick service restaurants. It also points out that there are twenty six (26) other registrations belonging to other entities that appropriate the word "JOLLY" in their marks.

The Respondent-Applicant maintains its right to use and register "JOLLY RANCHER" asserting that it has built its own goodwill thereto. It contends that to date, it has obtained one hundred seventy-three (173) trademark registrations for "JOLLY RANCHER" in no less than one hundred two (102) countries, including the Philippines. It furthers that if indeed there is conflict in the competing marks, the Opposer cannot claim prior rights over it since it has used its mark since 1949. Prior the present application, it has obtained registrations over the mark "JOLLY RANCHER" under Certificates of Registration Nos. 4-1996-107834, 4-2007-10168 and 4-2011-002067 issued respectively on 14 December 1999, 11 February 2008 and 04 August 2011. It thus finally posits that the opposition is barred by laches.

The Respondent-Applicant submitted the following as evidence:<sup>5</sup>

1. copies of its trademark registrations issued by various jurisdictions;
2. picture of "JOLLY RANCHER" products as sold in stores;
3. print-out trademark registrations and pending applications in the Philippines, and
4. affidavit of Rohit Grover.

The Preliminary Conference was conducted and terminated on 17 June 2014 wherein the parties were directed to file their respective Position Papers within ten days therefrom. After submission thereof, the case is deemed submitted for resolution.

Now, the issue to be resolved is whether the trademark "JOLLY RANCHER" should be allowed.

The records reveal that the Opposer has a valid and existing registration of its trademark "JOLLIBEE", which certificate was issued as early as 24 September 2005. The latter has several other registrations under its name including but not limited to: "JOLLIBEE LOGO AND DEVICE", "JOLLY ZERTS", "JOLLY SHAKES", "JOLLY KRUNCHY TWIRL", "JOLLY CRISPY FRIES" and "JOLLY CHEEZY FRIES" (hereafter collectively referred to as "Jollibee trademarks"). On the other hand, the Respondent-Applicant only filed the contested application on 29 October 2012. However, the records also reveal that it has been previously issued registrations of the mark "JOLLY RANCHER" under Certificates of Registration Nos. 4-1996-107834, 4-2007-10168 and 4-2011-002067, respectively, on 14 December 1999, 11 February 2008 and 04 August 2011.

---

<sup>5</sup> Marked as Exhibits "1" to "32".

But are the contending marks, as shown below, confusingly similar?

*Opposer's marks include the following:*

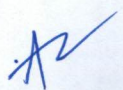
## **JOLLIBEE Jolly Hotdog**

The logo for "Jolly Crispy Fries" features the word "Jolly" in a large, bold, rounded font, with "Crispy" and "Fries" stacked below it in a similar, slightly smaller font. The text is white with a black outline and is set against a dark, irregular background.

*Respondent-Applicant's mark:*

The logo for "JOLLY rancher" features the word "JOLLY" in a large, bold, rounded font, with "rancher" below it in a smaller, lowercase font. The text is white with a black outline and is set against a dark, irregular background.

"JOLLY" is a common English word and hence, what will determine whether the marks are indeed confusingly similar are the words and/or device that accompany the same. In fact, the Trademark Registry shows many other registered marks belonging to different entities using the term for goods belonging to the same classes as the Opposer's. Apparently, the word "JOLLY" alone is not highly distinctive. In this case, the "JOLLY RANCHER" is distinguishable from any of the Opposer's "JOLLY" and "JOLLIBEE" marks. The Opposer failed to show its right to exclusively use the word "JOLLY" as it has no registration over the said word standing alone. Hence, the marks should be scrutinized in their entirety.

A handwritten signature in blue ink, appearing to be "AZ", is located in the bottom right corner of the page.

Moreover, the Opposer's goods and services can only be purchased and availed of in its restaurants and fast food chains while that of Respondent-Applicant in ordinary stores. In view thereof, it is highly improbable that the consumers will be deceived, or at least confused, that "JOLLY RANCHER" products are the same or are sourced from Opposer as they flow in different channels of trade.

Furthermore, records of this case reveal that the Respondent-Applicant has registered in the Philippines the "JOLLY RANCHER" mark as early as 14 December 1999, even before the registration of any of the Opposer's mark. In addition, both parties respectively registered its marks in Canada, Australia and Hong Kong, among other countries. Therefore, the two competing marks co-exist up to the present in commerce and no confusion and/or deception to the public was shown to have occurred. More importantly, it is underscored that the Respondent-Applicant's mark was registered in the Philippines even prior the Opposer.

Therefore, the mere use of "JOLLY" is insufficient to conclude that there is likelihood of confusion. It bears noting that some of these trademarks, as that of the Respondent-Applicant in this case, were applied for and/or used by their respective owners even prior the Opposer's application and/or use of its own "JOLLY" marks. To rule otherwise is tantamount to conferring upon the Opposer exclusive right over the common word "JOLLY". Doing so will have the unintended effect of opening doors for cancellation of valid and existing trademark registrations of parties using "JOLLY" as their trademark or a part thereof to the latter's damage and prejudice. The fact that the "JOLLY" marks co-exist in the market, each with its own distinctive presentation and coverage of goods or services, does not indicate a likelihood of confusion.

Consequent to the findings that there is no confusing similarity between "JOLLY RANCHER" and the Opposer's trademarks, there is no reason to delve on the issue of whether "JOLLIBEE" and its other family of marks are well-known.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.<sup>6</sup> It is found that Respondent-Applicant sufficiently met the requirements of the law.

---

<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-013201 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 18 May 2015.

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs